

Attorney Docket No: 33332-71679
PATENT



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Srikar Rao

Serial No.: 09/845,643 Art Unit: 3711

Filed: April 30, 2001 Examiner: Steven B. Wong

For: EZMARK

AMENDMENT

(Box Non-Fee Amendment)
Honorable Assistant Commissioner for
Patents
Washington, D.C. 20231

Sir:

This is in response to the office action mailed December 31, 2002.

Please add new claim 18 as indicated in the attachment. Claims 1, 3-7, 9, 10 and 13-18 are pending.

The office action rejects the present claims on three grounds: 1) claims 1, 3, 6, 7, 13, 16 and 17 are rejected over the patent to Giglio (U.S. Patent No. 5,795,248); 2) claims 4, 5, 9, 10 and 15 are rejected over Giglio in view of Kennedy (U.S. Patent No. 5,393,052); and 3) claim 14 is rejected over Giglio in view of Buckman (U.S. Patent No. 4,386,774).

With respect to the first ground, the office action does not address the limitation (of claims 1 and 6) that the clip is free of golf tee attachment surfaces. Such surfaces would not be desirable for the claimed golf ball marker and holder. The office action also does not address the limitation that the clip is sized for attachment to a shoe (claim 1) or being clipped to a shoe (claim 6). With respect to applicant's claims 13 and 17, the office action avers that it would have been obvious to form the clip in Giglio monolithically, but there is no explanation of how Giglio's clip portions such as the hook and pile fastener surface 22 would be formed monolithically with the metal clip and/or plastic body. It would not have been evident or obvious from Giglio to provide a ball marker holder comprising a monolithic strip having two portions as recited in applicant's claims 13 and 17. For at least these reasons, claims 1, 3, 6, 7, 13, 16 and 17 are not obviated by Giglio.

The first ground states that it would have been obvious to remove the golf tee attachment surface (48) from the accessory of Giglio in order to provide a simpler device and to form the clip of Giglio from a monolithic piece in order to simplify construction of the clip by permitting processes such as molding. These conclusions are improper since the office action does not provide proper motivation from the prior art for these conclusions. The examiner's attention is directed to Section 2143.01 of the Manual of Patent Examining Procedure (MPEP) which explains motivation by stating, in part,

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In the present instance the prior art itself does not provide the requisite motivation and there is no evidence of knowledge of persons of ordinary skill in the art that would provide motivation to modify Giglio to arrive at the claimed invention. Even the nature of the problem to be solved is not recognized by the prior art disclosure of Giglio and this is further

evidence of a lack of motivation. There is simply no suggestion in the prior art itself for modifying Giglio to arrive at the subject matter of claims 1, 3, 6, 7, 13, 16 and 17. Without the requisite motivation there is no *prima facie* case of obviousness. Accordingly, the rejection appears to be based on an impermissible hindsight view using the applicant's disclosure as a blueprint to reconstruct the claimed invention from prior art. Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor.¹

The second ground rejects claims 4, 5, 9, 10 and 15 over Giglio in view of Kennedy. The office action states that it would have been obvious to replace the means (32) of Giglio for removing the ball marker from the cavity with the indentation 16 of Kennedy in order to assist the user in removing the ball marker from the cavity. In Kennedy "16" is a ball mark holding recess (column 4, lines 17-18). In Giglio "32" is a planar bottom surface. Replacing Giglio's planar bottom surface with Kennedy's ball mark holding recess 16 would not have been obvious and probably would render Giglio's device inoperable since there would be no way to remove the marker (by sliding it into and out of recess 16 as in Kennedy) since sliding movement would be prohibited by the surrounding wall of cavity 14 in Giglio. Also, even if the alleged combination were possible (and such is not conceded) it would not arrive at the subject matter of claims 4, 9 and 15 since it would not provide at least one indentation positioned adjacent the circular recessed cavity (claims 4 and 9) or at least one indentation positioned adjacent the recess sized to receive a ball marker (claim 15). Replacement of Giglio's recess with Kennedy's recess at best would result in a recess, not an indentation adjacent a recess. For these reasons the second ground of rejection is not proper.

The second ground obviousness statement is also improper because there would have been no motivation for suggesting the modification alleged in the office action. What would have been the motivation to replace Giglio's recess? And why would one of ordinary skill in the art chose to replace it with a recess like that in Kennedy? There is no teaching or suggestion in the prior art which would suggest motivation for this change. On this basis the second ground of rejection is improper.

¹ See *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085, 1087, 37 USPQ 2d 1237, 1239 (Fed. Cir. 1995) (citing *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

Regarding new claim 15, the prior art of record does not teach or suggest the monolithic strip and means for releasably fixing a ball marker to the outer portion of the strip as recited in claim 15. Nor does the prior art teach or suggest an equivalent.² The claimed “means for” is required to be construed to cover the corresponding structure, material or acts described in applicant’s specification.³ None of the prior art markers and supportive structure function in the same manner as described in applicant’s disclosure.

The third ground rejects claim 14 over Giglio in view of Buckman. The office action states that it would have been obvious to have the ball marker of Giglio extend slightly past the recess in order to facilitate removal of the ball marker. Giglio’s ball marker storage cavity 24 is not suited for modification as suggested in the office action and the alleged modification is, at least for this reason, not obvious. In Buckman the cavity for holding the ball marker is open on one side and as seen in Fig.2 of Buckman a protruding lip portion of the ball marker is provided and by the recess being less than the thickness of the ball marker whereby the ball marker can be removed pushing on the protruding lip portion and sliding the ball mark toward the open unobstructed edge (to the right in Fig. 2 of Buckman). This would not be possible as the recess in Giglio is surrounded by a wall. The recess in Giglio does not have an unobstructed portion for this type of removal and is unsuited to have such configuration. For all of these reasons, and the above stated reasons with regard to the rejection of claim 13 (from which claim 14 depends), the rejection of claim 14 is improper.

New claim 18 adds that the clip is shaped for attachment to a shoe. Claim 18 is dependent on claim 1 and avoids the prior art for the same reasons as claim 1. Claim 18 is patentable over the prior art also for the additional limitation in claim 18.

In view of the above differences between the claims and the prior art, the omission of proper reasons for the obviousness conclusions and proper motivation, reconsideration of the above rejections is, respectfully, requested.

For all of the above reasons, claims 1, 3-7 and 9, 10, and 13-18 are allowable over the prior art of record.

The examiner is invited to telephone the undersigned if there is any issue remaining to be resolved.

² The criteria for making a case of equivalence is outlined at Section 2183 of the Manual of Patent Examining Procedure.

³ See *In re Donaldson*, 29 USPQ 2d, 1845, 1848.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages in other fees, be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 (33332-71679).

Respectfully submitted,
BARNES & THORNBURG



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